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SONNENSCHEIN NATH & ROSENTHAL LLP			ZIMMERMANN, JOHN P	
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WACKER DRIVE STATION, SEARS TOWER			2861	
CHICAGO, IL 60606-1080				

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12/04/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/563,660	OKUBO, MIWA	
	<b>Examiner</b>	<b>Art Unit</b>	
	John P. Zimmermann	2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 July 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 06 January 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. As mentioned in the previous action, the information disclosure statement (IDS) filed 30 November 2007 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of Foreign Patent Document #4, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The IDS has been placed in the application file and the considered documents have been initialed. Foreign Patent Document #4 "JP 2618359," was not considered and therefore crossed out as the applicant did not provide an English abstract for the document listed. Applicant purportedly submitted an IDS with the most recent correspondence (See Applicant Remarks, Page 1, Paragraph C - submitted 16 July 2008), but this IDS was not received by the Office (See Electronic Acknowledgement Receipt 16-JUL-2008). Furthermore, the document not previously considered by the Examiner remains as listed above. If Applicant would like Examiner to consider JP 01-283182, an appropriate IDS in compliance with 37 CFR 1.98(a)(3) referencing said document as well as applicable fees should be submitted.

### ***Drawings***

2. The drawings were originally objected to because the original drawings have Figures 5 & 6 as charts, the current specification labels the charts as tables in the specification and lists two tables, formerly labeled Tables 5 & 6 as Figures 5 & 6. The brief description says Figures 5 & 6 are "diagrams" (seem to mean charts), meanwhile the specification speaks to Tables 5 & 6 but

then shows the charts. The applicant continues to misunderstand the examiner's objection, this time as to mean the improper characterization of Figures 5 & 6 (16 JUL 2008 Amendment – Page 5, Remarks, Drawings Paragraph). The actual objection is to the inconsistent labeling of the Tables submitted as Figures or Drawings (Figures 5 & 6), the Waveforms submitted as Tables (Specification - Pages 19-20), and the Diagrams listed as Figures or Drawings (Specification – Brief Description of Drawing, Page 5, Lines 13-16). While Examiner agrees with Applicant that “both characterizations are accurate,” using multiple names for what is the same thing is inconsistent, hence the objection in an effort to prevent obfuscation of the record. Given the above reiteration of the previous objection, applicant's remarks are not applicable and the objection stands. Applicant specifically requested “authority” for the continued objection, and Examiner respectfully indicates requested “authority” as follows (Emphasis Added):

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In an effort to alleviate the confusion, Examiner respectfully suggests the following amendment(s) as a starting point to overcome the objection:

Specification, Page 5, Lines 13-15 replaced with:

FIG. 5 is a ~~diagram~~ tabular chart showing a relationship between the color interval and penetration unevenness; and

FIG. 6 is a ~~diagram~~ tabular chart showing a relationship between the Specification, Page 19, the Last Three Lines replaced with:

The results are shown in Tables 5 and 6, which are graphical representations of

the data, shown below, and FIGS. 5 and 6 which are tabular charts of the data.

[Table 5] Penetration Unevenness When Photographically

Printed on PM Photo Paper (Epson Corp.)

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Additionally, the drawings were originally objected to as failing to comply with 37 CFR 1.84(p)(5) because they included the following reference character(s) not mentioned in the description: “S” (Figure #2). As applicant still **has not** addressed this objection, the objection stands. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. Given that the application is subjected to PCT Rule 11, notably PCT 11.13 Special Requirements for Drawings:

- (l) Reference signs not mentioned in the description shall not appear in the drawings, and vice versa.
- (m) The same features, when denoted by reference signs, shall, throughout the international application, be denoted by the same signs.

The examiner respectfully points out that this objection in no way “imposes requirements beyond those imposed by the Patent Cooperation Treaty,” and is merely pointing out a specific rule that was not complied with, a rule “to require new drawings if the drawings were published without meeting all of the requirements under the PCT for drawings,” that echoes PCT Rule 11.13.

#### *Response to Amendment*

5. Applicant's amendment to **claims 1-6**, to include substantially more descriptive and further limiting claim language, has been recognized and examined as such.
6. Examiner notes Applicant's addition of **claims 7-10** and results of examination are presented below.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 1-2 & 4-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nakazawa et al.**, (US 2004/0001134 A1) in view of **Koitabashi et al.**, (US 2002/0097290 A1).

- a. As related to independent **claim 1**, Nakazawa et al. teaches an ink-jet recording method (Nakazawa et al. – Title) in which recording is executed by discharging inks of a plurality of colors from a discharge opening as droplets of ink to be attached onto a recording material (Nakazawa et al. – Background, Paragraph 5; Summary, Paragraphs 8 & 11 and Detailed Description, Paragraph 58) wherein in the case where the interval between a discharge of an ink of a first color and a discharge of an ink of a second color is 200 mS or less [i.e. 15kHz = 67µS which is less than 200mS] (Nakazawa et al. – Examples, Page 15, Paragraph 138, Specifically the 7<sup>th</sup> line from the end of the

Paragraph), inks whose surface tension is 25 to 45 mN/m at 23° C. are used for each of the multiple inks varied colors (Nakazawa et al. – Detailed Description, Paragraphs 118 & 120). Additionally, Nakazawa et al. teaches a variety of recording material to include high quality papers, micro-coated papers, and dedicated inkjet papers (Nakazawa et al. – Detailed Description, Paragraph 137). Regarding the use of a specific recording material the claimed description of the print medium is merely nonfunctional descriptive material, not related to the actual recording method and it does not carry patentable weight.

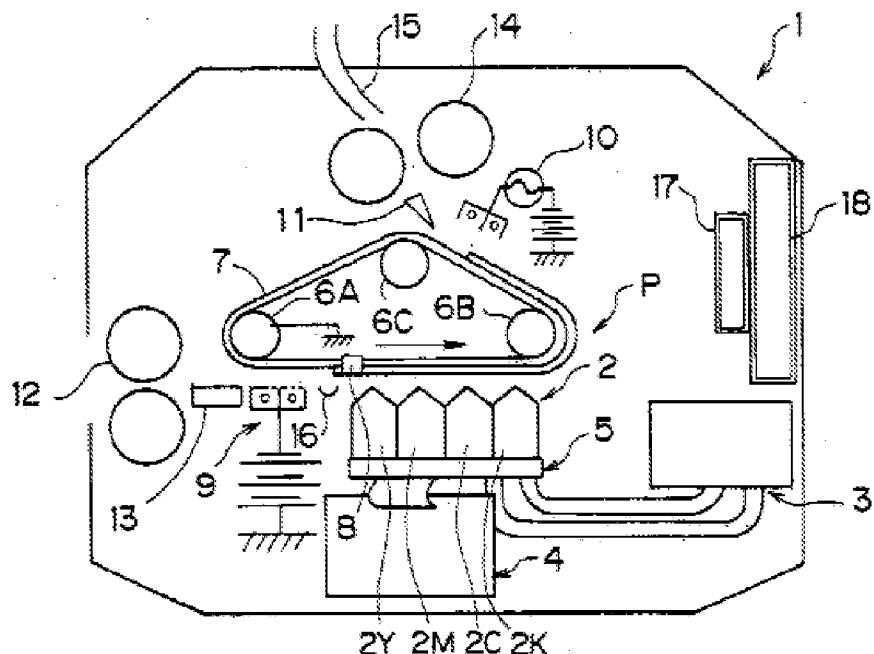
**However**, in an effort to further prosecution, Examiner recognizes Nakazawa et al. teaches a variety of recording material can be used, which would include the recording medium with the claimed features. **Additionally**, Koitabashi et al. **specifically** teaches recording material with ink absorption amount in 100mS of 15mL/m<sup>2</sup> or more [i.e. 100mL/ m<sup>2</sup>] (Koitabashi et al. – Detailed Description, Paragraph 61).

Given the same field of endeavor, specifically an ink-jet recording method which merely discharges ink, uses ink and uses recording material, and an ink-jet printer, it is apparent that one of ordinary skill in the art at the time the invention was made would have been motivated to combine the method and apparatus of ink-jet recording using any of a variety of recording medium as taught by Nakazawa et al. with the specific ink-jet recording medium as taught by Koitabashi et al. and was readily available to one of ordinary skill in the art at the time of the invention, in an effort to use the most effective medium available as an improvement over the existing options at the time particularly in super high speed printers with full line head printing capabilities (Koitabashi et al. – Detailed Description, Paragraph 42).

b. As related to dependent **claim 2**, the combination of Nakazawa et al. and Koitabashi et al. remains as applied above and continues to teach discharging the first ink and second ink using a line head (Nakazawa et al. – Detailed Description, Paragraph 91).

c. As related to independent **claim 4**, Nakazawa et al. teach an ink-jet printer (Nakazawa et al. – Title) in which recording is executed by discharging inks of a plurality of colors from a discharge opening as droplets of ink to be attached onto a recording material (Nakazawa et al. – Background, Paragraph 5; Summary, Paragraphs 8 & 11; Detailed Description, Paragraph 58 and Figure 1, Reference #2Y, #2M, #2C & #2K, shown below).

FIG. 1



d. Continuing with **claim 4**, Nakazawa et al. goes on to teach an interval between a discharge of an ink of a first color and a discharge of an ink of a second color is 200 mS

or less [i.e. 15kHz = 67 $\mu$ S which is less than 200mS] (Nakazawa et al. – Examples, Page 15, Paragraph 138, Specifically the 7<sup>th</sup> line from the end of the Paragraph), inks whose surface tension is 25 to 45 mN/m at 23° C. are used for said inks of each color (Nakazawa et al. – Detailed Description, Paragraphs 118 & 120). Additionally, Nakazawa et al. teaches a variety of recording material to include high quality papers, micro-coated papers, and dedicated inkjet papers (Nakazawa et al. – Detailed Description, Paragraph 137). Examiner recognizes Nakazawa et al. teaches a variety of recording material can be used, which would include the recording medium with the claimed features. ***Additionally***, Koitabashi et al. ***specifically*** teaches recording material with ink absorption amount in 100mS of 15mL/m<sup>2</sup> or more [i.e. 100mL/ m<sup>2</sup>] (Koitabashi et al. – Detailed Description, Paragraph 61).

Given the same field of endeavor, specifically an ink-jet printer which merely discharges ink and uses recording material, it is apparent that one of ordinary skill in the art at the time the invention was made would have been motivated to combine the method and apparatus of ink-jet recording using any of a variety of recording medium as taught by Nakazawa et al. with the specific ink-jet recording medium as taught by Koitabashi et al. and was readily available to one of ordinary skill in the art at the time of the invention, in an effort to use the most effective medium available as an improvement over the existing options at the time particularly in super high speed printers with full line head printing capabilities (Koitabashi et al. – Detailed Description, Paragraph 42).

e. As related to dependent **claim 5**, the combination of Nakazawa et al. and Koitabashi et al. remains as applied above and continues to teach discharging the first ink and second ink using a line head (Nakazawa et al. – Detailed Description, Paragraph 91).

10. **Claims 3 & 6-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nakazawa et al.**, (US 2004/0001134 A1) and **Koitabashi et al.**, (US 2002/0097290 A1) as applied to **claims 1 & 4**, above and further in view of **Koitabashi et al.** (US 6,612,691 B1).

a. As related to dependent **claim 3**, the combination of Nakazawa et al. and Koitabashi et al. teaches the limitation of **claim 1** for the reasons above. Additionally, Nakazawa et al. teaches a variety of recording material to include high quality papers, micro-coated papers, and dedicated inkjet papers (Nakazawa et al. – Detailed Description, Paragraph 137). Regarding the use of a specific recording material the claimed description of the print medium is merely nonfunctional descriptive material, not related to the actual recording method and it does not carry patentable weight. **However**, in an effort to further prosecution, Examiner recognizes Nakazawa et al. teaches a variety of recording material can be used, which would include the recording medium with the claimed features. **Additionally**, Koitabashi et al. ('691) teaches use of recording material having an ink absorption amount in 100mS between 15mL/m<sup>2</sup> and 99 mL/m<sup>2</sup> [i.e. 10-50 mL/m<sup>2</sup> for Semi-penetrative ink and 50+ mL/m<sup>2</sup> for high-penetrative ink] (Koitabashi et al. – Title; Abstract; Summary, Column 3, Lines 1-20; Detailed Description, Column 10, Line 64 – Column 11, Line 36; Table 1; and Figure 47, both shown below).

Koitabashi et al. (691) - TABLE I

	$\eta_{sp}$ value (ml/cm <sup>2</sup> · min <sup>0.5</sup> )	Acetylenol content (%)	Surface tension (dyn/cm)
Logging type (non-penetrative) ink	~1.0	0.0-0.2	40-
Semi-penetrative ink	1.0-5.0	0.2-0.7	35-40
High-penetrative ink	5.0-	0.7-	~35

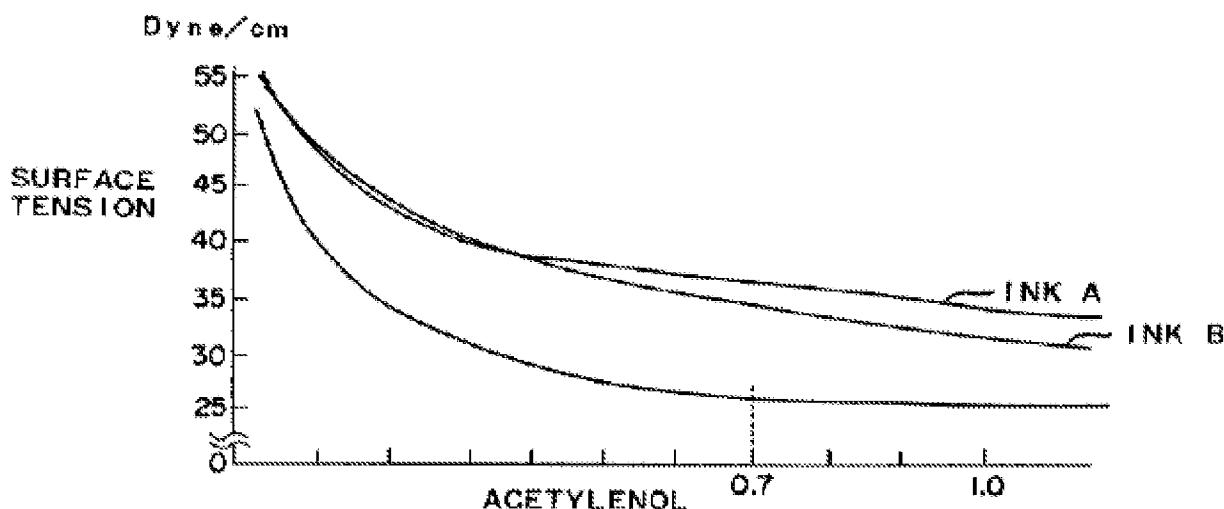


FIG. 47

b. As related to dependent **claims 7 & 9**, the combination of Nakazawa et al. and Koitabashi et al. teaches the limitation of **claim 1** for the reasons above. Additionally, Nakazawa et al. teaches a variety of recording material to include high quality papers, micro-coated papers, and dedicated inkjet papers (Nakazawa et al. – Detailed Description, Paragraph 137). Regarding the use of a specific recording material the claimed description of the print medium is merely nonfunctional descriptive material, not related to the actual recording method and it does not carry patentable weight. **However**,

in an effort to further prosecution, Examiner recognizes Nakazawa et al. teaches a variety of recording material can be used, which would include the recording medium with the claimed features. ***Additionally***, Koitabashi et al. ('691) teaches use of recording material having an ink absorption amount in 100mS between 15mL/m<sup>2</sup> {18mL/m<sup>2</sup>} and 40 mL/m<sup>2</sup> [i.e. 10-50 mL/m<sup>2</sup> for Semi-penetrative ink] (Koitabashi et al. – Title; Abstract; Summary, Column 3, Lines 1-20; Detailed Description, Column 10, Line 64 – Column 11, Line 36; Table 1; and Figure 47, both shown above).

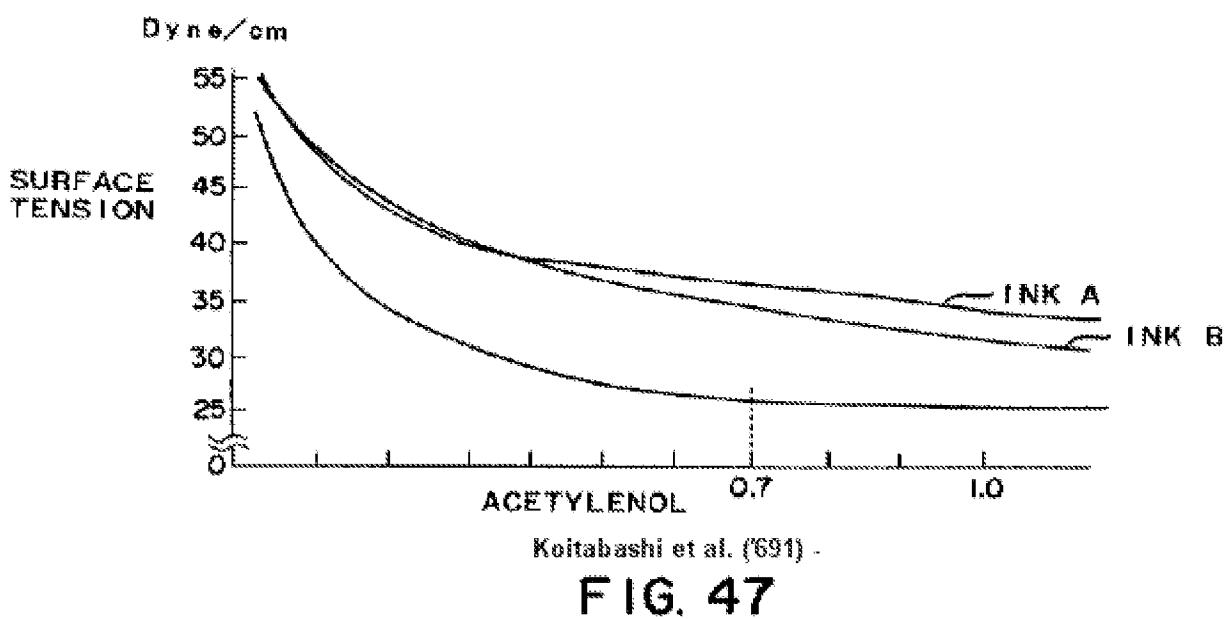
Given the same field of endeavor, specifically an ink-jet recording method which merely discharges ink, uses ink and uses recording material, and an ink-jet printer, it is apparent that one of ordinary skill in the art at the time the invention was made would have been motivated to combine the method and apparatus of ink-jet recording using any of a variety of recording medium as taught by Nakazawa et al. and the specific ink-jet recording medium as taught by Koitabashi et al. that was readily available to one of ordinary skill in the art at the time of the invention, with the further detailed recording material used in relation to the ink in use as taught by Koitabashi et al. ('691), in an effort to use the most effective medium available as an improvement over the existing options at the time particularly in super high speed printers with full line head printing capabilities (Koitabashi et al. – Detailed Description, Paragraph 42), while merely using that which was available to one of ordinary skill in the art at the time of the invention, in this case to the same inventor [i.e. Koitabashi et al.].

c. As related to dependent **claim 6**, the combination of Nakazawa et al. and Koitabashi et al. teaches the limitation of **claim 4** for the reasons above. Additionally, Nakazawa et al. teaches a variety of recording material to include high quality papers, micro-coated papers, and dedicated inkjet papers (Nakazawa et al. – Detailed

Description, Paragraph 137). Examiner recognizes Nakazawa et al. teaches a variety of recording material can be used, which would include the recording medium with the claimed features. **Additionally**, Koitabashi et al. ('691) teaches use of recording material having an ink absorption amount in 100mS between 15mL/m<sup>2</sup> and 99 mL/m<sup>2</sup> [i.e. 10-50 mL/m<sup>2</sup> for Semi-penetrative ink and 50+ mL/m<sup>2</sup> for high-penetrative ink] (Koitabashi et al. – Title; Abstract; Summary, Column 3, Lines 1-20; Detailed Description, Column 10, Line 64 – Column 11, Line 36; Table 1; and Figure 47, both shown below).

Koitabashi et al. ('691) - TABLE 1

	Xa value (mL/m <sup>2</sup> · mLs <sup>0.5</sup> )	Acetylenol content (%)	Surface tension (dyn/cm)
Tapping type (non-penetrative) ink	~1.0	0.0-0.2	48-
Semi-penetrative ink	1.0-5.0	0.2-0.3	35-40
High-penetrative ink	5.0-	0.7-	~35



d. As related to dependent **claims 8 & 10**, the combination of Nakazawa et al. and Koitabashi et al. teaches the limitation of **claim 4** for the reasons above. Additionally, Nakazawa et al. teaches a variety of recording material to include high quality papers, micro-coated papers, and dedicated inkjet papers (Nakazawa et al. – Detailed Description, Paragraph 137). Examiner recognizes Nakazawa et al. teaches a variety of recording material can be used, which would include the recording medium with the claimed features. **Additionally**, Koitabashi et al. ('691) teaches use of recording material having an ink absorption amount in 100mS between  $15\text{mL/m}^2$  { $18\text{mL/m}^2$ } and  $40\text{ mL/m}^2$  [i.e.  $10\text{-}50\text{ mL/m}^2$  for Semi-penetrative ink] (Koitabashi et al. – Title; Abstract; Summary, Column 3, Lines 1-20; Detailed Description, Column 10, Line 64 – Column 11, Line 36; Table 1; and Figure 47, both shown above).

Given the same field of endeavor, specifically an ink-jet printer which merely discharges ink and uses recording material, it is apparent that one of ordinary skill in the art at the time the invention was made would have been motivated to combine the method and apparatus of ink-jet recording using any of a variety of recording medium as taught by Nakazawa et al. and the specific ink-jet recording medium as taught by Koitabashi et al. that was readily available to one of ordinary skill in the art at the time of the invention, with the further detailed recording material used in relation to the ink in use as taught by Koitabashi et al. ('691), in an effort to use the most effective medium available as an improvement over the existing options at the time particularly in super high speed printers with full line head printing capabilities (Koitabashi et al. – Detailed Description, Paragraph 42), while merely using that which was available to one of ordinary skill in the art at the time of the invention, in this case to the same inventor [i.e. Koitabashi et al.].

***Response to Arguments***

11. Applicant's arguments with respect to **claims 1 & 4** have been considered but are moot in view of the new ground(s) of rejection.
12. With respect to **claim 1** and therefore **claims 2-3, 7, & 9**, which inherently contain all of the limitations of independent **claim 1**, applicant amended the independent claim to incorporate previously dependent limitations including language that does not require a step to be performed [i.e. a specific type of recording medium]. Additionally, Applicant argued that "one of ordinary skill in the art would never combine Koitabashi with Nakazawa..." and "a hypothetical combination would not provide the invention as recited... Koitabashi then teaches away from any lower absorption amounts..." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Due to these amendments, a further search was necessitated thereby producing additional prior art of record as well as a more specific notation of the existing prior art of record and henceforth a new grounds of rejection. In response to Applicant's argument that "one of ordinary skill in the art would never combine Koitabashi with Nakazawa..." Examiner has provided a new ground(s) of rejection that specifically address the newly incorporated limitations of amended **claim 1**, and Applicant is requested to see the rejection detailed above for further response to Applicant's argument of patentability. In response to Applicant's argument that "a hypothetical combination would not provide the invention as recited... Koitabashi then teaches away from any lower absorption amounts..." Examiner respectfully disagrees per *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362

(Fed. Cir. 1997) (Koitabashi et al. expressing a preference for a higher ink absorption rate provides motivation for one of ordinary skill in the art to focus on the bottom of Koitabashi et al.' suitable range of 100-200 mL/m<sup>2</sup> desirable that the absorption amount be 100mL/m<sup>2</sup> and to explore acceptable levels below that range). As no further arguments were made, all dependent claims have been rejected accordingly.

13. With respect to **claim 4** and therefore **claims 5-6, 8, & 10**, which inherently contain all of the limitations of independent **claim 4**, applicant amended the independent claim to incorporate previously dependent limitations. Additionally, Applicant argued that "one of ordinary skill in the art would never combine Koitabashi with Nakazawa..." and "a hypothetical combination would not provide the invention as recited... Koitabashi then teaches away from any lower absorption amounts..." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use {in this case using a variety of recording material}, then it meets the claim. Due to these amendments, a further search was necessitated thereby producing additional prior art of record as well as a more specific notation of the existing prior art of record and henceforth a new grounds of rejection. In response to Applicant's argument that "one of ordinary skill in the art would never combine Koitabashi with Nakazawa...", Examiner has provided a new ground(s) of rejection that specifically address the newly incorporated limitations of amended **claim 1**, and Applicant is requested to see the rejection detailed above for further response to Applicant's argument of patentability. In response to Applicant's argument that "a hypothetical combination would not provide the invention as recited... Koitabashi then teaches

away from any lower absorption amounts..." Examiner respectfully disagrees per *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (Koitabashi et al. expressing a preference for a higher ink absorption rate provides motivation for one of ordinary skill in the art to focus on the bottom of Koitabashi et al.' suitable range of 100-200 mL/m<sup>2</sup> desirable that the absorption amount be 100mL/m<sup>2</sup> and to explore acceptable levels below that range). As no further arguments were made, all dependent claims have been rejected accordingly.

### ***Conclusion***

14. ***Examiner's Note:*** Examiner has cited particular Figures & Reference Numbers, Columns, Paragraphs and Line Numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Zimmermann whose telephone number is (571)270-3049. The examiner can normally be reached on Monday - Thursday, 7:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Luu can be reached on 571-272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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